

REMARKS

By this Amendment, Applicants propose amending claims 1, 8 and 15. Applicants do not propose adding or canceling any claims. Claims 1-15 and 26 are currently pending.

Regarding the Final Office Action:

In the Final Office Action, the Examiner rejected claims 1-15 and 26 under 35 U.S.C. § 112, first paragraph; and rejected claims 1-15 and 26 under 35 U.S.C. § 103(a) as unpatentable over Aoshima et al. (U.S. Patent No. 6,241,524, hereinafter "Aoshima") in view of Yamada (U.S. Patent No. 6,149,523), and further in view of Applicants' Admission of Prior Art (hereinafter "AAPA").

Applicants appreciate the Examiner's thorough examination of this application, especially the detailed citations which aided Applicants in reviewing the Examiner's comments. Nevertheless, Applicants respectfully traverse these rejections.

Regarding the Rejections under 35 U.S.C. § 112, First Paragraph :

Applicants respectfully traverse the Examiner's rejection of claims 1-15 and 26 under 35 U.S.C. § 112, first paragraph. The Examiner stated that "it does not appear to be disclosed in the specification that the special action to which the user is given prompts was never before operable during the game," and "[i]t also does not appear to be disclosed in the specification that the special action will become operable for the first time in the game." See Office Action, p. 2. Applicants respectfully disagree. In the Request for Reconsideration filed January 16, 2004, Applicants showed support in the Specification at pages 14 and 15. In addition to the arguments presented in the previous Request for Reconsideration, Applicants respectfully point out to the Examiner that the support also comes from, for example, Figure 6 and its related descriptions in the Specification.

The claim language “wherein the special action was never before operable during the game” finds support in the Specification. As shown in Figure 6, for example, the player plays the game in Step 316, in which “the protagonist character actually competes with the competing character,” and special actions can be performed against the competing character (Specification, p. 18 lines 5-15). Before the player can perform special actions against the competing character, however, the competing character must appear as in Step 310. Therefore, before the competing character appears for the first time, the special action is not operable. Furthermore, prior to Step 312, in which the competing character could appear for the first time, the practice mode program is executed in Step 310. In Step 310, the practice mode program decides whether to perform Step 318 and Step 320, or go directly to Step 312, as two aspects of the present invention. In either aspect, it is only after Step 310 that the special actions are operable and the game is proceeded to Step 312. It is clear that the special operation cannot be operable without going through Step 310 first. Therefore, the special operation was never before operable during the game until the player goes through practice mode (Step 310) for the very first time, where the player is prompted about the special action for the first time. It follows then that “wherein the special action was never before operable during the game,” recited in claim 1 finds support in the Specification at least in the example given above. Also, the claim language of claim 15, “wherein the special action was never before operable during the game,” likewise finds support. Step 310 and Step 312 are then repeated whenever a different scene or a different competing character appears, therefore new special operations become available. (Specification, pp. 17-20). The fact that Applicants want to proceed with claims covering not all the aspects of the disclosed inventions does not make the claims non-enable under 35 U.S.C. § 112, first paragraph.

Therefore, Applicants respectfully request withdrawal of rejection of claims 1-15 and 26 under 35 U.S.C. § 112, first paragraph.

Applicants also submit that the newly added limitation to claim 1, “means for activating the operation of the special action of the displayed object for the first time during the game,” is also supported by the disclosure for the reasons stated above.

Regarding the Rejections under 35 U.S.C. § 103(a)

Applicants respectfully traverse the Examiner’s rejection of claims 1-15 and 26 under 35 U.S.C. § 103(a) as unpatentable over Aoshima in view of Yamada, and further in view of AAPA. In order to establish a prima facie case of obviousness, three basic criteria must be met. The prior art reference (or references when combined) must teach or suggest all the claim elements. There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. There must be a reasonable expectation of success. See M.P.E.P. § 2143.

Claims 1, 8, and 15, as amended, call for combinations including, for example, “processing a prompt that provides training for a key operation corresponding to a special action of a displayed object of a game, wherein the special action was never before operable.” As conceded by the Examiner, Aoshima and Yamada fail to teach “processing a prompt that provides training for a key operation corresponding to a special action of a displayed object of a game, wherein the special action was never before operable,” as required by Claims 1, 8, and 15. See Office Action, p. 6. The Examiner stated, however, that “[t]hough neither Aoshima et al. nor Yamada explicitly state that the special action of the game for which the advice is being presented was never before operable; such functionality is disclosed by the Applicant to be

known in the art.” (Office Action, p. 6). Particularly, the Examiner relied on the second paragraph on page 2 of the Specification:

In this practice mode, the type of keys to be operated and the order in which they are operated or pressed are displayed on the screen in a window format. By pressing the keys in the order indicated, the player causes the displayed object, such as a character, to use the corresponding special techniques. When the key operations corresponding to the key operations indicated cannot be made, the displayed object cannot use the special techniques that are the object. The player can practice the key operations until the displayed object can use these techniques.

The Examiner then drew a conclusion that “the player is prompted for a special action never before operable the action becomes operable for a first time in the game once all the key operations are correct,” without further reasoning. See Office Action, p. 6. Applicants respectfully disagree. The paragraph above merely states how the prior art practice mode works: the player presses a sequence of keys in order to use the special techniques; if the player is not able to press the sequence of keys as indicated, the player is not able to use the special technique corresponding to the key operations; the player can practice the key operation until the player can press the right sequence of keys to use the special techniques. This paragraph does not teach whether or not the special action was never before operable. Therefore, AAPA fails to cure Aoshima’s and Yamada’s deficiencies on the teaching of “processing a prompt that provides training for a key operation corresponding to a special action of a displayed object of a game, wherein the special action was never before operable,” as required by proposed amended claims 1, 8, and 15.

Therefore, Aoshima, Yamada, or AAPA, taken alone or reasonably combined, fail to teach each and every element in claims 1, 8, and 15. Applicants respectfully submit that a prima facie case of obviousness cannot be established, thus, claims 1, 8, and 15 are nonobvious over

Aoshima in view of Yamada, and further in view of AAPA under 35 U.S.C. § 103(a).

Furthermore, if an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. Because claims 2-7 and 9-12 directly or indirectly depend on claim 1, and claims 13, 14, and 26 directly or indirectly depend on claim 8, Applicants further submit that claims 2-7, 9-14, and 26 are nonobvious over Aoshima in view of Yamada, and further in view of AAPA under 35 U.S.C. § 103(a). Applicants respectfully request withdrawal of rejection of claims 1-15 and 26.

Conclusion

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-15 and 26 in condition for allowance. Applicants also submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time under 37 C.F.R. § 1.136 required in entering this response. If there are any fees due under 37 C.F.R. § 1.16 or 1.17, including any fees required

for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our deposit account
06-0916.

Respectfully submitted,

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